Preliminary Matter

Applicant respectfully requests that the Examiner return the initialed PTO/SB/08 for the Information Disclosure Statement filed on February 7, 2005.

Obviousness-type Double Patenting Rejection

The Examiner maintained the rejections of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6,501,232. Applicant submits herewith a terminal disclaimer. Accordingly, Applicant respectfully requests the Examiner to withdraw this rejection.

Statement of Substance of the Interview and Prior Art Rejection

With respect to the prior art rejection, the Examiner maintained the rejection of claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,434,380 to Magara et al. (hereinafter "Magara"). In view thereof, Applicant has conducted an in person interview with the Examiner. Applicant thanks the Examiner for a courteous in person interview on November 23, 2005. During the Interview, the rejection of claim 1 as being anticipated by Magara was discussed.

That is, claim 1 recites "a quantity of supply of hard coat material by the emission of electrode material is a predetermined value determined according to a predetermined processing condition." For example, the control unit sets a first pulse width and a first peak value so that an electric current density between the electrodes is in a predetermined range which suppresses emission of electrode material, wherein extension of an electric discharge arc column occurs during the period of the first pulse width. However, the control unit sets another pulse width and peak value (*i.e.*, the k-th pulse width and the k-th peak value) so that a quantity of supply of hard

coat material by the emission of electrode material is a predetermined value determined according to a predetermined processing condition. That is, the supply of hard coat material is the emitted electrode material. In other words, the hard coat is made of an electrode material (*see e.g.*, technical field on page 1 of the specification).

Magara, on the other hand, relates to minimizing surface roughness (col. 9, lines 37-39). That is, Magara discloses a machining gap, between an electrode and a workpiece being filled with a dielectric mixture containing metallic or submetallic powder. The apparatus uses a swinging mechanism to move the electrode during processing. The apparatus uses a high-voltage superposition circuit to superpose a voltage of 100-400 V across the gap. The apparatus uses a current limiting resistor to ensure that the main circuit supplies a low voltage of approximately 100 V to the machining gap (*see* Abstract).

Magara, however, focuses on forming a smooth surface layer on a workpiece *i.e.*, forming a layer as smooth as possible on the workpiece (col. 9, lines 37 to 41). This smooth surface layer is formed of dielectric with silicon particles that are provided in the gap and not of the electrode material. In other word, Magara uses dielectric with silicon particles to prevent the electrode material from sticking to the workpiece. Specifically, "[d]isposing the silicon particles in such a manner ensures that almost all of the particles adhered to or absorbed into the workpiece are silicon particles rather than electrode material" (col. 5, lines 24-31). In short, the hard coat material is not formed by the emission of electrode material. On the contrary, in Magara, the electrode material is prevented from sticking to the workpiece.

Therefore, "a quantity of supply of hard coat material by the emission of electrode material is a predetermined value determined according to a predetermined processing

condition," as set forth in claim 1 is not disclosed in Magara, which lacks having the emission of electrode material supply material for the hard coat. For at least these exemplary reasons, claim 1 is not anticipated by Magara.

Claims 2 and 3 recite features similar to those found in claim 1. Accordingly, claims 2 and 3 are not anticipated by Magara, based on a rationale analogous to that set forth above for claim 1.

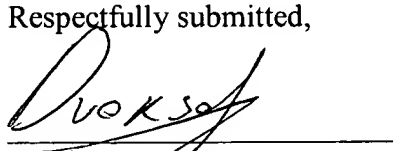
Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Applicant respectfully submits that if a new Office Action becomes necessary, this Office Action should be Non-Final as the claims were not amended in the previous response.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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